

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-22, 34-57, 70-93, 106-117, and 124-135 are pending in the present application. Claims 1, 2, 12, and 13 are amended and Claims 23-33, 58-69, 94-105, 118-123, and 136-292 are canceled without prejudice by the present amendment.

In the outstanding Office Action, Claims 9, 10, 11, 20, 21, 22, 43, 44, 45, 55, 56, 57, 79, 80, 81, 91, 92, and 93 were objected to; Claims 1-4 were rejected under 35 U.S.C. § 102(b) as anticipated by Takeda (U.S. Patent No. 5,937,750); Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Kanno (U.S. Patent No. 6,718,872); Claim 7 was rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Kanno and Tomono et al. (U.S. Patent No. 5,400,065, herein "Tomono"); Claim 8 was rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Ozaki et al. (U.S. Patent No. 5,207,157, herein "Ozaki"); Claim 9 was rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Ito (Japanese Patent Application No. JP 410166805); Claim 11 was rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Ito and Tanaka et al. (Japanese Patent Application No. JP 2001-239733, herein "Tanaka"); Claims 12-15 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai et al. (Japanese Patent Application No. JP 2002-172839, herein "Asai") in view of Takeda; Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Takeda and Kanno; Claim 18 was rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Takeda, Kanno, and Tomono; Claims 19 and 20 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Takeda and Ozaki; Claim 22 was rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Takeda, Ozaki, and Tanaka; Claims 34, 38, 70, and 74 were rejected under 35 U.S.C. § 103(a) as unpatentable

over Takeda in view of Hiroshi et al. (Japanese Patent Application No. JP 05-70010, herein “Hiroshi”); Claims 39, 40, 75, and 76 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Hiroshi and Kanno; Claim 41 was rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Hiroshi, Kanno, and Tomono; Claims 43 and 79 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Hiroshi and Ito; Claims 42 and 78 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Hiroshi and Ozaki; Claims 45 and 81 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Hiroshi and Tanaka; Claims 46, 55, 82, and 91 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Hiroshi; Claims 50, 55, 86, and 91 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Hiroshi, Takeda, and Ito; Claims 51, 52, 87, and 88 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Hiroshi, Takeda, Ito, and Kanno; Claims 53 and 89 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Hiroshi, Takeda, Ito, Kanno, and Tomono; Claims 54 and 90 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Hiroshi, Takeda, Ito, and Ozaki; Claims 56 and 57 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Hiroshi, Takeda, Ito, and Tanaka; Claim 77 was rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda, Hiroshi, and Tomono; Claims 92 and 93 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Hiroshi, Takeda, Ito, and Tanaka; Claims 106, 107, and 109 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Hiroshi; Claims 110 and 111 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Hiroshi and Kanno; Claims 112 and 113 were rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Hiroshi; Claim 115 was rejected under 35 U.S.C. § 103(a) as unpatentable over Asai in view of Hiroshi and Takeda; Claims 116 and 117 were rejected under 35 U.S.C. § 103(a) as unpatentable over Takeda in view of Hiroshi and Kanno; Claims

124-135 were allowed; and Claims 10, 21, 35-37, 44, 47-49, 71-73, 80, 83-85, 108, and 114 were indicated as allowable if rewritten in independent form.

Applicants thank the Examiner for the indication of allowable subject matter. However, because Claims 1 and 12 have been amended to overcome the applied art, Claims 10, 21, 35-37, 44, 47-49, 71-73, 80, 83-85, 108, and 114 are maintained in dependent form.

Regarding the objection to the claims, Applicants respectfully submit that each of the objected claim recites (i) a press roller, (ii) a roller, and (iii) "said roller." Thus, Applicants respectfully submit that the term "said roller" clearly refers to the roller (ii) and not to the press roller (i). In other words, Applicants respectfully submit that a roller and a press roller are different rolls and labeled accordingly to distinguish one from the other and referring back to "said roller" does not create any ambiguity. Regarding the remaining of the objected claims, Applicants respectfully submit that all those claims recite the same two rollers, i.e., a roller and a press roller. Accordingly, it is respectfully requested this objection be withdrawn.

Regarding the outstanding rejections on the merits, independent Claims 1 and 12 have been amended to recite that a fluorine compound layer includes "a film tube closely fitted on the surface of said elastic body." The claim amendments find support in originally filed Claims 2 and 13. Thus, it is believed that no new matter has been added.

The rejections of the independent claims is addressed next with regard to the following groupings of independent claims: 1 and 12; 34, 46, 70, and 82; and 106 and 112.

Addressing the first group of independent claims, i.e., Claims 1 and 12, independent Claim 1 is directed to a printer that includes, *inter alia*, at least one press roller facing a print drum. The press roller includes an elastic body having a fluorine compound layer on a surface of the elastic body. The fluorine compound layer includes a film tube closely fitted on the surface of the elastic body. Independent Claim 12 has been amended similar to Claim

1. In a non-limiting example, Figure 2 shows the press roller 13 having the elastic body 13d and the fluorine compound layer 13e including the film tube closely fitted on the surface of the elastic body 13d.

Turning to the applied art, Takeda shows in Figure 1 a printer having a press roller 20. Further, Takeda shows in more detail in Figures 3 and 4 that the press roller 20 includes a metal core 21 and a conductive rubber layer 22 wrapped around the core 21.<sup>1</sup> In another embodiment of Takeda shown in Figure 11, a press roller 26 might have a thick insulating layer 26a “formed of a fluorine-based or an epoxy-based paint.”<sup>2</sup> Thus, Takeda specifically discloses that the insulating layer 26a is based on a fluorine-based **paint**, which is different from the claimed **film tube** closely fitted on the surface of the elastic body.

In addition, Takeda discloses at column 8, lines 35-37, that “the insulating layer 26a may be implemented by a commercially available thermally shrinkable tube formed of an insulating material.” However, Takeda does not teach or suggest that the alternative insulating layer 26a could be made from a thermally shrinkable tube that also includes fluorine.

In other words, Takeda discloses (i) either painting the body of the press roller with fluorine-based paint, which is different from a fluorine compound layer including a film tube closely fitted, or (ii) using a thermally shrinkable tube formed of an insulating material but the shrinkable tube does not include fluorine.

Applicants respectfully submit that each alternative disclosed by Takeda is different from the claimed press roller. Accordingly, it is respectfully submitted that independent Claims 1 and 12 and each of the claims depending therefrom patentably distinguish over Takeda.

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<sup>1</sup> Takeda, column 4, lines 15-18.

<sup>2</sup> Id. column 8, lines 31-35.

The outstanding Office Action relies on the combination of Asai and Takeda for rejecting independent Claim 12 discussed above. Asai has been considered but does not cure the deficiencies of Takeda discussed above. Accordingly, it is respectfully submitted that independent Claim 12 and each of the claims depending therefrom patentably distinguish over Asai and Takeda, either alone or in combination.

Addressing now the group of independent Claims 34, 46, 70 and 82, Applicants note that each of these claims recite a printer that includes, *inter alia*, a press roller that has an elastic body on which a film is formed with fine projections. In a non-limiting example, Figure 15 shows the press roller 142 having the elastic body 142d and the projections 142g.

The outstanding Office Action has relied on a combination of Asai, Takeda, and Hiroshi for rejecting this group of claims. More specifically, the outstanding Office Action has relied on Hiroshi for teaching a roller with projections on a surface of the roller. Hiroshi shows in Figures 1 and 2 a paper feed roller 11 having a **metallic** cylindrical body and having on the surface of the metal body rough fine irregular shapes as disclosed in the English abstract of Hiroshi.

Initially, Applicants note that the paper feed roller of Hiroshi is different from a press roller facing a print drum for pressing a sheet-like pressing member against a printer drum as required by Claims 34, 46, 70, and 82. At least for this reason, Applicants respectfully submit that one of ordinary skill in the art would not use at the paper feed roller of Hiroshi for forming a press roller given the fact that the functions and structure of the paper feed roller and the press roller are different.

In addition, Applicants note that the paper feed roller of Hiroshi has a metal body and through etching the rough irregular shapes are formed on the surface of the paper feed roller. However, each of Claims 34, 46, 70, and 82 recites that the press roller has an elastic body on which a film is formed with fine projections. Thus, Applicants respectfully submit that

forming a film with projections on a surface of an elastic body is different from forming irregular shapes on the metallic cylindrical body of Hiroshi through etching. Moreover, it is likely that an elastic body cannot be etched.

Accordingly, it is respectfully submitted that independent Claims 34, 46, 70, and 82 and each of the claims depending therefrom patentably distinguish over Asai, Takeda, and Hiroshi, either alone or in combination.

Regarding independent Claims 106 and 112, Applicants note that each of these claims recites a press roller that is configured to press a sheet-like recording medium against a print drum and the press roller has a surface formed with a number of projections that have a defined peak and mean pitch. The outstanding Office Action relies on a combination of Takeda and Hiroshi for rejecting independent Claim 106. In addition, the outstanding Office Action states at page 20, second full paragraph, that Hiroshi “does not explicitly disclose a peak radius, a peak angle and a mean pitch” but however, “it has been held that while the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.”

Applicants note that the assertion of the outstanding Office Action that Hiroshi discloses “the general conditions of a claim” is not accurate because no English translation of Hiroshi has been provided and therefore, it cannot be asserted that Hiroshi discloses the peak radius, the peak angle and the mean pitch. It might be as well the case that Hiroshi discloses values for the peak radius, the peak angle, and the mean pitch which are different from the claimed values. Unless the Office relies on a full English translation of Hiroshi, it is not clear whether Hiroshi discloses or not a peak radius, a peak angle, and a mean pitch of the conical projections 15. Therefore, if the next Office Action maintains the rejections of Claims 106 and 112 based on Hiroshi, Applicants respectfully submit that a full English translation of Hiroshi be provided.

In this last regard, note that MPEP § 706.02 II (“RELIANCE UPON ABSTRACTS AND FOREIGN LANGUAGE DOCUMENTS IN SUPPORT OF A REJECTION”) makes it clear that when both the English abstract and the underlying document in another language are available and both are prior art, reliance on the abstract means that only the facts in the abstract can be relied upon, “not additional facts that may be contained in the underlying full text document.” This MPEP § 707.02 prohibition is violated by the outstanding Office Action that clearly relies on an assertion in addition to the “abstract” of Hiroshi.

In addition, this portion of the MPEP makes it clear that citation of and reliance on the abstract alone can only be made part of a rejection under “limited circumstances” that include “a non-final” Office Action with translation being supplied with the next Office Action. See the last paragraph of MPEP § 706.02 II on page 700-21 of Rev. 2, May 2004.

Further, as discussed above regarding Claims 34, 46, 70, and 82, Hiroshi discloses a paper feed roll having a metal body (not an elastic body) that is etched to form rough fine irregular shapes. However, the metal body with irregular shapes of Hiroshi is different from the claimed press roller having a surface formed with a number of projections as required by Claims 106 and 112.

Accordingly, Applicants respectfully submit that independent Claims 106 and 112 and each of the claims depending therefrom patentably distinguish over Takeda, Hiroshi, and Asai, either alone or in combination.

Regarding the remaining rejections of the dependent claims, each reference relied upon by the outstanding Office Action has been considered but does not cure the deficiencies of Asai, Takeda, and Hiroshi discussed above. Accordingly, it is respectfully submitted that all dependent claims are also allowable for the same reasons as discussed above.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action that effect is respectfully requested.

Respectfully submitted,

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